

REMARKS

The following remarks are responsive to the Office Action mailed on 24 February 2006. Applicants respectfully request reconsideration of the pending application.

Office Action Summary

The arrangement of the specification has been objected to for missing a summary of the invention. The specification has been objected to because the term VPI/VCI looks like VPINCI. Claims 1-28 have been rejected under 35 USC § 112, second paragraph. Claims 1-9 and 17-24 have been rejected under 35 USC § 103(a) as being unpatentable over applicants' alleged admitted prior art in view of US Patent 6,243,384 of Eriksson et al ("Eriksson"). Claims 10-16 and 25-28 have been rejected under 35 USC § 103(a) as being unpatentable over Eriksson in view of US Patent 6,208,623 of Rochberger et al ("Rochberger").

Status of Claims

At the time the Office Action was mailed, claims 1-28 were pending in the application. In the present response, claims 1, 10 and 17 have been amended. No claims have been added or canceled. Therefore, claims 1-28 remain pending in the application.

Summary of the Invention

The Office Action requested that Applicants add a "Summary of the Invention" description to the application. Applicants would like to kindly point out that both the MPEP and 37 CFR § 1.73 do not require the presence of a "Summary of the Invention" in a patent application. They merely indicate where in the application the "Summary of the Invention" should be placed if Applicants were to elect to include one.

In particular, 37 CFR § 1.73 only states that "[a] brief summary of the invention ... should precede the detailed description." (emphasis added). 37 CFR § 1.73 does not state "must" or "shall." Accordingly, Applicants have elected not to include a "Summary of the Invention" as this is within the discretion of Applicants.

Amendments to the Specification

Paragraphs [0006], [0010], [0012] and [0045] have been amended to replace the term VPI/VCI with the term VPI-VCI for improved readability.

The specification has been amended to incorporate the text of claims 1, and 10, as filed. Applicants submit that under 35 USC § 112, second paragraph, the claims as filed constitute a part of the specification. Therefore, the present amendment does not introduce any new matter. In particular, paragraph [0041] has been amended to incorporate the subject matter of claim 1, as filed and paragraph [0044] has been amended to incorporate the subject matter of claim 10, as filed.

Rejections Under 35 U.S.C. §112

Claims 1-28 have been rejected under 35 USC § 112, second paragraph, By way of the present response, applicants have amended independent claim 1 to clarify an existing limitation. With respect to independent claims 1, 10, 17 and 25, the Office Action states that:

[I]t appears that the independent claims are based on Figure 5. The claims fail to particularly point out and distinctly claim the subject matter in that the issuing step and the propagating step have no support in the specification.

(2/24/06 Office Action, p. 3).

It appears that the Office Action cites 35 USC § 112, second paragraph as a ground for rejection and then asserts a 35 USC § 112, first paragraph (written description) rationale. Applicants respond here to the Examiner's rationale for rejection.

In considering whether there is 35 USC 112, first paragraph support for the claim limitation, the examiner must consider not only the original disclosure contained in the summary and the detailed description of the invention portions of the specification, but also the original claims, abstract and drawings.

(MPEP 2181 citing *In re Mott*, 5.39.F.2d 1291, 1299).

Therefore, the original claims must be considered in assessing compliance with 35 USC § 112. Applicants submit that the amendments to paragraphs [0041] and [0044] described above provide explicit support for at the issuing step in the subject claim limitations, without incorporating new matter, by incorporating the original claim language into the specification.

Applicants have amended claims 1 and 17, without prejudice, to delete the propagating step in each of claims 1 and 17, rendering moot the rejection of those claims on the stated grounds. Applicants respectfully point out that independent claims 10 and 25 do not include “issuing” or “propagating” steps. Therefore, the arguments set forth in the Office Action are inapposite with respect to claims 10 and 25. Applicants submit, therefore, that all of the rejections under 35 USC § 112 have been overcome.

Rejections Under 35 U.S.C. §103

Claims 1-9 and 17-24 have been rejected under 35 USC § 103(a), as being unpatentable over Applicants’ alleged admitted prior art in view Eriksson, incorporating details of the rejection set forth in a previous Office Action (8/31/05 Office Action). The previous Office Action states that:

Applicants’ sole argument on patentability is that the address change is contained within SIG information. Firstly, SIG is prior art as admitted by Applicants on Figure 3. The claims give a label SIG to the address change information (see item b in claim 1, for example). The specification describes the acronym as a[sic] filed within a payload. Applicants’ Figure 3 shows that SIG field is prior art and is well known in Eriksson’s PNNI ATM network. It would have been obvious to a person of ordinary skill in the art to give a label such as acronym SIG. Furthermore, Applicants fail to provide arguments why the acronym SIG is patentable over the applied references.

(8/31/05 Office Action, pp. 3-4).

Applicants submit that the Office Action fails to establish a *prima facie* case of obviousness because the combination of Eriksson and the alleged prior

art do not teach or suggest all the limitations of the subject claims. Furthermore, even if the purported combination did teach or suggest all of the limitations of the subject claims, the Office Action fails to establish the motivation to combine the references as required to establish a *prima facie* case of obviousness.

As a preliminary matter, applicants respectfully submit that the Office Action mischaracterizes applicants' previous response(s) as to admissions, the content of applicants' previous arguments, and the language of the subject claims. Contrary to the Office Action's statement, applicants do not "give a label SIG to the address change information." Nor do applicants claim the acronym SIG, as erroneously stated in the Office Action. Applicants claim "issuing from [a] node information describing [an] address change within a SIG field in a PNNI Topology State Element," as recited in claim 1 below. It should be obvious that the information within a SIG field is not the same thing as the name "SIG."

Claim 1

Claim 1 recites:

A method, comprising:

- a) receiving, at a node, notification of an address change of said node, wherein said node is within a PNNI ATM network, and wherein said node comprises a destination endpoint for an SPVC that flows within said PNNI ATM network to said node; and
- b) issuing from said node information describing said address change within a SIG field in a PNNI Topology State Element (PTSE).**

(emphasis added).

The Office Action cites to Eriksson as a prior art example of an ATM PNNI network, but fails to cite any teaching or suggestion in Eriksson for “issuing from [a] node information describing [an] address change within a SIG field,” as recited in claim1. In fact, Eriksson contains no references to SIG fields or address changes at all. Therefore, Eriksson does not teach or suggest the subject limitation of claim 1. Furthermore, assuming *arguendo* that a SIG field in a PTSE is prior art, the Office Action fails to establish that the alleged prior art teaches a SIG field containing address change information, or that teaches or suggests “issuing from [a] node information describing [an] address change within a SIG field,” as recited in claim1. Therefore, Eriksson and the alleged prior art, either alone or in combination, do not teach or suggest the subject limitation.

Applicants further submit that, even if Eriksson and the alleged prior art could be combined in the manner suggested by the Office Action, there is no motivation to make such a combination. “It is well established that “[t]he level of skill in the art cannot be relied on to provide the suggestion to combine references.” MPEP 2143.01 (*citing Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999)). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (*citing In re Mills*, 916 F.2d 180 (Fed. Cir. 1990)) (emphasis in original). The Office Action fails to point out any suggestion in Eriksson for a

combination with the alleged prior art, nor any suggestion in the alleged prior art for a combination with Eriksson.

Applicants respectfully submit, therefore, that claim 1 is patentable over the cited references for at least the reasons discussed above.

Claims 2-9

Given that claims 2-9 depend from claim 1, and include all of the limitations of claim 1, applicants further submit that claims 2-9 are also patentable over the cited references.

Claim 17

Claim 17 recites:

A machine readable medium having stored thereon sequences of instructions which, when executed by a digital processing system, cause said system to perform a method, comprising:

issuing from a node information describing an address change to said node within a SIG field in a PTSE, wherin said node is within a PNNI ATM network, and wherein said node comprises a destination endpoint for an SPVC that flows within said PNNI ATM network to said node.

(emphasis added).

The Office Action cites to Eriksson as a prior art example of an ATM PNNI network, but fails to cite any teaching or suggestion in Eriksson for “issuing from [a] node information describing [an] address change within a SIG field in a PTSE,” as recited in claim 17. In fact, Eriksson contains no references to SIG fields or address changes at all. Therefore, Eriksson does

not teach or suggest the subject limitation of claim 17. Furthermore, assuming *arguendo* that a SIG field in a PTSE is prior art, the Office Action fails to establish that the alleged prior art teaches a SIG field containing address change information, or that teaches or suggests “issuing from [a] node information describing [an] address change within a SIG field,” as recited in claim 17. Therefore, Eriksson and the alleged prior art, either alone or in combination, do not teach or suggest the subject limitation.

Applicants further submit that, even if Eriksson and the alleged prior art could be combined in the manner suggested by the Office Action, there is no motivation to make such a combination. “It is well established that “[t]he level of skill in the art cannot be relied on to provide the suggestion to combine references.” MPEP 2143.01 (*citing Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999)). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (*citing In re Mills*, 916 F.2d 180 (Fed. Cir. 1990)) (emphasis in original). The Office Action fails to point out any suggestion in Erickson for a combination with the alleged prior art, nor any suggestion in the alleged prior art for a combination with Eriksson.

Applicants respectfully submit, therefore, that claim 17 is patentable over the cited references for at least the reasons discussed above.

Claims 18-24

Given that claims 18-24 depend from claim 17, and include all of the limitations of claim 17, applicants further submit that claims 18-24 are also patentable over the cited references.

Claims 10-16 and 25-28 have been rejected under 35 USC §103(a) as being unpatentable over Eriksson in view of Rochberger.

Applicants submit that the Office Action fails to establish a *prima facie* case of obviousness because the combination of Eriksson and Rochberger does not teach or suggest all the limitations of the subject claims. Furthermore, even if the purported combination did teach or suggest all of the limitations of the subject claims, the Office Action fails to establish the motivation to combine the references as required for a *prima facie* case for obviousness.

Claim 10

Claim 10 recites:

A method, comprising:

a) **receiving at a node within a PNNI ATM network, information describing an address change of an other node within said PNNI ATM network**, wherein said other node comprises a destination endpoint for an SPVC that flows within said PNNI ATM network to said other node, said information comprising an old address for said other node and a new address for said other node, **said information contained within a SIG field in a PTSE**;

b) comparing said old address for said other node with an SPVC destination node address maintained by said node to establish an SPVC connection supported by said node; and

c) replacing said SPVC destination node address with said new address if said old address and said SPVC destination node address match.

(emphasis added).

As noted above, Eriksson contains no references to SIG fields or address changes. Therefore, Eriksson does not teach or suggest “receiving at a node within a PNNI ATM network, information describing an address change of an other node within [the] PNNI ATM network, . . . said information contained within a SIG field in a PTSE,” as recited in claim 10.

A prior Office Action states that Rochberger discloses updating a network address database (2/18/05 Office Action, p. 5), but fails to point out how updating an address database has anything to do with changing the address of a network node using address information within a SIG field of a PTSE, as recited in claim 10.

Rochberger teaches a method for updating a network topology database so that each node in a network can determine the addresses of its network neighbors and whether it becomes connected to a new neighbor (Rochberger, col. 6, lines 24-36).

Rochberger does not teach or suggest **changing** the address of a node, nor does Rochberger teach or suggest receiving address information within a SIG field of a PTSE. Therefore, Rochberger does not teach or suggest “receiving at a node within a PNNI ATM network, information describing an address change of an other node within [the] PNNI ATM network, . . . said information contained within a SIG field in a PTSE,” as recited in claim 10.

Therefore, Eriksson and Rochberger, alone or in combination, do not teach or suggest the subject limitation of claim 10.

Applicants further submit that, even if Eriksson and Rochberger could be combined in the manner suggested by the Office Action, there is no motivation to make such a combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (*citing In re Mills*, 916 F.2d 180 (Fed. Cir. 1990)) (emphasis in original). The Office Action does not identify any suggestion in Eriksson for a combination with Rochberger. Similarly, the Office Action does not identify any suggestion in Rochberger for a combination with Eriksson.

Applicants respectfully submit, therefore, that claim 10 is patentable over the cited references for at least the reasons discussed above.

Claims 11-16

Given that claims 11 through 16 depend from claim 10, and include all of the limitations of claim 10, applicants respectfully submit that claims 11 through 16 are also patentable over the cited references.

Claim 25

Claim 25 recites:

A machine readable medium having stored thereon sequences of instructions which, when executed by a digital processing system, cause said system to perform a method, comprising:

- a) receiving, at a node in a PNNI ATM network, a PTSE having SIG information that includes an old address for an SPVC endpoint within said network and a new address for said SPVC endpoint within said network;
- b) comparing said old address with an SPVC destination node address maintained by said node to establish an SPVC connection supported by said node; and
- c) replacing said SPVC destination node address with said new address if said old address and said SPVC destination node address match.

(emphasis added).

As noted above, Eriksson contains no references to SIG fields or nodal address changes. Therefore, Eriksson does not teach or suggest “receiving, at a node in a PNNI ATM network, a PTSE having SIG information that includes an old address for an SPVC endpoint within [the] network and a new address for [the] SPVC endpoint within [the] network,” as recited in claim 25.

A prior Office Action states that Rochberger discloses updating a network address database (2/18/05 Office Action, p. 5), but fails to point out how updating an address database has anything to do with changing the address of an SPVC endpoint using address information within a SIG field of a PTSE, as recited in claim 25.

Rochberger teaches a method for updating a network topology database so that each node in a network can determine the addresses of its network neighbors and whether it becomes connected to a new neighbor (Rochberger, col. 6, lines 24-36). Rochberger does not teach or suggest changing the address of a node, nor does Rochberger teach or suggest receiving address information within a SIG field of a PTSE. Therefore, Rochberger does not teach or suggest

the subject limitation of claim 25. Therefore, Eriksson and Rochberger, either alone or in combination, do not teach or suggest the subject limitation of claim 25.

Applicants further submit that, even if Eriksson and Rochberger could be combined in the manner suggested by the Office Action, there is no motivation to make such a combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (*citing In re Mills*, 916 F.2d 180 (Fed. Cir. 1990)) (emphasis in original). The Office Action does not identify any suggestion in Eriksson for a combination with Rochberger. Similarly, the Office Action does not identify any suggestion in Rochberger for a combination with Eriksson.

Applicants respectfully submit, therefore, that claim 25 is patentable over the cited references for at least the reasons discussed above.

Claims 26-28

Given that claims 26-28 depend from claim 25, and include all of its limitations, applicants further submit that claims 26-28 are also patentable over the cited references.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully submit that all objections and rejections have been overcome and that all pending claims are in condition for allowance. Applicants reserve all rights with respect to the doctrine of equivalents.

If there are any additional charges, please charge them to our Deposit Account Number 02-2666. If a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Richard W. Thill at (408) 720-8300.

Respectfully submitted,

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